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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

POU920000205US1

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on January 3, 2007

Signature

Typed or printed name Michelle L. Wyss

Application Number

09/748,716

Filed

12/22/2000

First Named Inventor

Sara ELO DEAN et al.

Art Unit

2173

Examiner

Dennis G. Bonshock

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 37,333

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Jon Gibbons

Typed or printed name

(561) 989-9811

Telephone number

January 3, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	09/748,716	Confirmation No. 5358
Applicant	:	Sara Elo Dean	
Filed	:	12/22/2000	
TC/A.U.	:	2173	
Examiner	:	Dennis G. BONSHOCK	
Docket No.	:	POU920000205US1	
Customer No.	:	23334	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are submitted with the Applicant's notice of appeal. The only issue on appeal is whether the Applicant's declaration under 37 CFR 1.131, submitted on May 17, 2006 and amended and resubmitted on November 2, 2006, is sufficient to overcome the Carroll Jr. reference.

In the Final Office Action of August 3, 2006, claims 1-9, 11-31, and 33-39 were rejected under 35 U.S.C. §102(e) as being anticipated by Carroll, Jr. (U.S. Patent Application Number 2002/0085020) and claims 10 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carroll, Jr. (U.S. Patent Publication Number 2002/0085020) in view of Stapel et al. (U.S. Patent Publication Number 2002/0087571).

The evidence submitted with Applicant's November 2, 2006 affidavit under 37 CFR 1.131 includes test results (Exhibit H), feedback from others corroborating the test results (Exhibit G), as well as source code (Exhibit J), review of the source code (Exhibit F), state charts (Exhibit C), screen shots (Exhibit I), and more (Exhibits A, B, D, and E). More specifically, Exhibit G is a February 2, 2000 email sent to non-inventors informing them that a version of the present invention was available for download. The email has a caveat section informing the email recipients that the inventors have already performed tests and inserted tests in the inventive program that is the subject of the email. Exhibit H is an email from a non-inventor that is a response to the Exhibit G email. Exhibit H shows that the non-inventor provided feedback to the functioning invention and stated that he was "very impressed with the functionality." Therefore, the

invention was actually working prior to the effective date of Carroll Jr. The Applicant's November 2<sup>nd</sup>, 2006 affidavit under 37 CFR 1.131 included a chart showing a clear, direct relationship between the claims of the pending application and the evidence submitted (Exhibits A-G).

The chart, in conjunction with the submitted evidence, unequivocally demonstrates that the present invention was conceived and reduced to practice *prior to* the effective date of Carroll Jr. Applicants submit that Carroll has been removed as a reference under 35 U.S.C. 102 and under 35 U.S.C. 103, that the application is in a condition for allowance, and that the Examiner's continued rejection is improper.

As stated in 37 CFR 1.131(b), the documentary evidence with a declaration requires that "the showing of facts [ ] be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained."

The purpose of filing a 37 CFR 1.131 affidavit is not to demonstrate prior invention, *per se*, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA, 1340, 444 F. 2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 USC 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id.* at 1353, 444 F. 2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice,' which must be established under the rule, need not be the same as what is required in the 'interference' sense of those terms." *Id.*; accord, *In re Barkowski*, 505 F. 2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974). "In interference practice, conception, reasonable diligence, and reduction to practice require

corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects.” MPEP § 715.07, *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

Notwithstanding the lower standard for showing reduction to practice under 37 CFR 1.131 as compared to interference practice, and the fact that Section 715.07(III) of the MPEP states that “averments made under 37 CFR 1.131 affidavits or declarations do not require corroboration,” on November 2<sup>nd</sup>, 2006, Applicants filed an affidavit under 37 CFR 1.131 that included over 140 pages of evidence with test results corroborating the fact that reduction to practice of the present invention occurred prior to the filing date of Carroll Jr. The Applicants note that this identical evidence was deemed more than sufficient in the co-pending U.S. Patent Application Serial No. 09/747,871 (the ‘871 Application) entitled “Method and Apparatus For End-to-End Content Publishing System Using XML with An Object Dependency Graph” with inventors Peter E. Davis, Sara Elo Dean, Dikran S. Meliksetian, Jeffery Milton, Louis Weitzman, and Nianjun Zhou to swear behind a reference and thereby result in the allowance of the ‘871 Application. The instant application was filed on December 22, 2000 - the same date as the ‘871 Application.

The evidence submitted with Applicant’s November 2, 2006 affidavit under 37 CFR 1.131 includes test results (Exhibit H), feedback from others corroborating the the test results (Exhibit G), as well as source code (Exhibit J), review of the source code (Exhibit F), state charts (Exhibit C), screen shots (Exhibit I), and more (Exhibits A, B, D, and E). More specifically, Exhibit G is a February 2, 2000 email sent to non-inventors informing them that a version of the present invention was available for download. The email has a caveat section informing the email recipients that the inventors have already performed tests and inserted tests in the inventive program that is the subject of the email. Exhibit H is an email from a non-inventor that is a response to the Exhibit G email. Exhibit H shows that the non-inventor provided feedback to the functioning invention and stated that he was “very impressed with the functionality.” Therefore, the

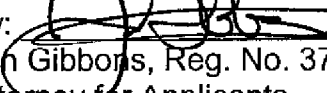
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The chart, in conjunction with the submitted evidence, unequivocally demonstrates that the present invention was conceived and reduced to practice *prior to* the effective date of Carroll Jr. Applicants submit that Carroll has been removed as a reference under 35 U.S.C. 102 and under 35 U.S.C. 103, that the application is in a condition for allowance, and that the Examiner's continued rejection is improper.

Applicant's hereby respectfully request reconsideration and allowance of pending claims 1-39 of the instant application.

Respectfully submitted,

Date: January 3, 2006

By:   
Jon Gibbons, Reg. No. 37,333  
Attorney for Applicants